REMARKS

The effect of the amendment to the specification is to remove a superfluous punctuation mark (a period). The application, as amended, contains no new matter.

The Examiner rejected Claims 1 through 8 under 35 U.S.C. § 103(a) "as being unpatentable over Burns (U[.]S[. Patent] 5,942,009 [, (issued 24 August 1999]), writing

> Burns (US' [sic] 009) teaches a method for the same-day permanent waving and coloring of hair comprising the steps of contacting the hair with a pre-wrap solution, and placing on rods if the hair is to be curled [sic], the hair is processed using a waving agent, the excess is preferably removed, contacting the hair with a coloring composition containing an oxidizing colorant to develop color and rebound the hair (see abstract) and further, contacting the hair with additional oxidizing agent (neutralizing agent) and optionally shampooing the hair (see col. 5, lines 20-22). Burns also teaches the steps of drying the hair while at least some of the first composition and/or optional second composition is still in contact with the hair so that substantially all of the hair is dry (see col. 5, lines 12-15).
>
> The claims [of the present application] differ from the reference by reciting a method for coloring portions of the hair while at the same sitting waving other portions of the hair.
>
> However, the reference of Burns teaches a method for permanent waving and coloring of hair with less time and without damage to the hair (see col. 8 lines 27-53).
>
> Therefore, it would have been obvious to one having an ordinary skill in the art at the time of the invention to apply the claimed method for waving specific portions of hair while coloring other portions of hair with a reasonable expectation of success because the reference teaches [a] similar method for waving and dying hair in less than three hours wherein the method impacts improved shape retention, color receptivity, color stability, color retention, shine, strength, and/or color evenness to hair and that the hair also has a more lustrous appearance and the method further, [sic] resulted in saving time and money (see col. 8, lines 27-35), and, thus, [sic] the person of the ordinary skill [sic] in the art would expect such a method to have similar properties and results to those claimed, absent, [sic] unexpected results.

Action, pages 2-3.

The Examiner has correctly summarized the teaching of Burns. However, he has drawn incorrect conclusions regarding the teaching of Burns as it relates to my invention and incorrectly applied the law in asserting that Burns renders the claims of my application obvious.

> Obviousness is a legal conclusion which we are required to draw from facts appearing in the record... Thus before we can conclude that any disclosed invention is "obvious" under the conditions specified in 35 U.S.C. [§] 103, we must evaluate facts

> from which to determine ... what was shown in the prior art at the time the invention was made §. Here, ... the record ... [does not] suppl[y] the factual data necessary to support the legal conclusion of obviousness of the invention at the time it was made. We are unwilling to substitute speculation and hindsight appraisal of the prior art for such factual data.

In re Sporck, 301 F.2d 686, 690-691, 113 USPQ (BNA) 360, 364 (C.C.P.A. 1962).

"[O]bviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter." *In re Bell*, 991 F.2d 781, 782, 26 USPQ2d (BNA) 1529, 1531 (Fed. Cir. 1993).

The Examiner has recognized the difference between the teaching of Burns and the teaching of my invention, Action page 1 and as cited above. But the Examiner has incorrectly concluded that because Burns "teaches a method for permanent waving and coloring of hair with less time and without damage to the hair," "Action page 1 and as cited above, Burns somehow renders my invention obvious.

As the Examiner has recognized in his remarks cited above, the entire teaching of Burns is directed to a method, or in the terminology of Burns a "process," for both waving and coloring a subject's hair. In the Burns method, one strand or portion of the subject's hair receives both a waving and a coloring treatment. Burns ABSTRACT, lines 9-14 ("[T]he hair is processed using a waving agent ... and then contacted with a coloring composition."). I disclose and claim, conversely, a method for highlighting and waving hair in which "no portion of a subject's hair receives both a waving treatment and a highlighting treatment in the same sitting." SUMMARY OF THE INVENTION, first paragraph, lines 6 and 7. The SUMMARY earlier in its first paragraph, at lines 1 and 2, defines "highlighting" as the equivalent of "coloring." Burns, therefore, teaches away from the method of my invention. It is the selective waving and coloring of separate portions of a subject's hair that is novel and not obvious in view of the prior art, including Burns and the references that I cited in my disclosure

Burns asserts certain advantages, e.g. less time and lack of damage to hair, derived from the use of his "process." In my disclosure, I have asserted similar benefits and advantages that will flow from the practice of my invention. Mere assertions of claimed advantages obtained from the use of a method contain no substantive information relating to the steps taken in practicing that method. Such

assertions cannot "suggest[] the claimed subject matter," *In re Bell* (cited above), and therefore cannot support a finding of obviousness under the law.

Despite the Examiner's correct reading but incorrect analysis of Burns, that reference fails to teach or suggest the method of my invention but rather teaches away from it and does not support his rejection of my claims.

I therefore believe that my application, as amended, is in condition for allowance and request reconsideration and allowance in due course.

Respectfully submitted,

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I certify that this correspondence has been deposited with the United States Postal Service as first class mail addressed to Commissioner of Patents and Trademarks, P.O. box 1450 Alexandria, Virginia 22313-1450 on Oct 27, 2003.

Sandra Guy Brown

Signature